REMARKS

I. STATUS OF THE CLAIMS

Claims 1, 4-11, 13-23 and 25 are canceled. New claims 26-49 are added. Claim 24 has been amended to include the limitation of claims 2 and 11 as originally filed and is further supported by the instant specification (as published) at [0002], [0004], and [0019]. Claims 26-33 are dependent on claim 24 and are supported by the claims as originally filed. Independent claim 34 is supported by claim 24 as originally filed and the specification at [0002], [0004], and [0019]. Claims 35-49 are dependent on claim 34 and are supported by the claims as originally filed. Accordingly, no new subject matter is added.

II. REJECTIONS UNDER 35 U.S.C. § 112

In the Office Action, the Examiner states that the previous rejection of claims 6 and 7 under 35 U.S.C. § 112, second paragraph, has been withdrawn. Final Office Action at 2.

The Examiner rejects claim 10 under 35 U.S.C. § 112, second paragraph, as allegedly "being indefinite for failing to particularly point out and distinctly claim the subject matter to which applicant regards as the invention." *Id.* Applicants respectfully submit that this rejection is now moot in view of the amendments presented herein.

III. REJECTIONS UNDER 35 U.S.C § 103

"The proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all of the facts." M.P.E.P. §2141

(III). Applicant takes the position that after consideration of all the facts herein, the combination and modification of references relied on by the Examiner does not render the present claims obvious.

As an initial matter, several basic factual inquires must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

(1) Determine the scope and content of the prior art;

(2) Ascertain the differences between the prior art and the claims in issue;

(3) Resolve the level of ordinary skill in the pertinent art; and

(4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; *see also KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007).

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." M.P.E.P. § 2142. In fact, the Supreme Court, in its decision in *KSR Int'l Co. v. Teleflex*, further instructed that the analysis supporting a rejection under 35 U.S.C. § 103 "should be made explicit." 127 S.Ct. 1727, 1741, 82 U.S.P.Q.2d 1385, 1396 (emphasis added) (citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")). Exemplary rationales

that may support a conclusion of obviousness include, *inter alia*, "simple substitution of one known element for another to obtain predictable results" and "some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention." M.P.E.P. § 2143.

Finally, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). For each of the §103 rejections below, the Examiner has failed to provide a rationale for why one of ordinary skill in the art would modify the prior art reference to arrive a the the present claims, taking into consideration all the words in the claims.

A. Rejection over Bolich

The Examiner rejects claims 1-2, 4-10, and 13-25 under 35 U.S.C. § 103(a) as allegedly "being unpatentable over Bolich et al (6,635,240)" ("*Bolich*"). Final Office Action at 3. The Examiner states that Bolich discloses

> aerosol hair styling compositions which comprise (a) from about 5% to about 90% of a water soluble polyalkylene glycol (polyol) that has an average molecular weight of from about 190 to about 1500 and from about 5 to about 35 repeating alkylene oxide radicals wherein each of the repeating alkylene oxide radicals has from 2 to 6 carbon atoms; (b) from about 1% to 90% of a liquid carrier; and (c) from about 5% to about 40% of a propellant.

Office Action at 3-4. The Examiner further contends that Bolich discloses compositions further comprising "a gelling agent . . . in an amount from about 0.1% to about 10%. *Id.* at 5. The gelling agents include cross linked carboxylic acid polymers, such as

Carbopol, "which contain unneutralized acid monomers (anionic polymer)." *Id.* The Examiner admits that "Bolich does not exemplify the instant concentrations of propellant and Carbopol." *Id.* at 6. However, the Examiner points to Bolich's teaching of propellant in an amount of 5-40%, and gelling agent in an amount of 0.1-10%, and the Examiner alleges that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to look at the guidance provided by Bolich et al and manipulate the concentrations of the propellant and carbopol in the composition." *Id.* at 6-7. Applicants submit that the rejection of the claims is moot in light of the present amendment.

Bolich does not teach or suggest the method as recited in amended claim 24 and new claim 34 "wherein the cosmetic method imparts a waxy effect to the hair." A composition with a waxy effect is understood as meaning "a pasty composition for holding and/or fixing the individual hairs together by means of a certain slicking or greasing effect without the hardening effect of fixing sprays, while at the same time preserving the natural gloss of the hair." Specification at [0004]. As noted in the present specification, "[t]he majority of hair styling products with a waxy effect are presented in the form of a more or less viscous paste which is applied to the hair by hand." Specification at [0007]. While Bolich teaches methods for styling dry hair, Bolich is silent with respect to a composition or a method which can impart a waxy effect to the hair.

For at least these reasons, Applicant respectfully requests that this rejection be withdrawn.

B. Rejection over *Birkel*

In the Office Action, the Examiner rejects claims 1-2, 4-11, and 13-25 under 35 U.S.C. § 103(a) as allegedly "being unpatentable over Birkel et al (2001/0003584)" ("*Birkel*"). Final Office Action at 12. The Examiner states that "Birkel teaches a hair composition comprising (a) a terpolymer present in the composition in an amount of 0.01% to 20% and (b) a[n] anionic polymer present in an amount of from 0.01% to 20%. . . ." *Id.* at 12. The Examiner points out that the examples of Birkel utilize 10% water and above. *Id.* at 13. The Examiner states that Birkel teaches that "[e]thylene glycol (polyol), glycerol (polyol), and propylene glycol (polyol) in an amount of up to 30 percent by weight are especially preferred water-soluble solvents." *Id.* (emphasis in original). The Examiner admits that Birkel does not provide an example comprising the instant glycols as co-solvents in any of the examples. *Id.* at 14. The Examiner alleges that

> it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the instant polyols in the instant concentration in the examples. One would have been motivated to do so with a reasonable expectation of success and similar results since Birkel teaches the use of organic co-solvents such as ethylene glycol, glycerol, and propylene glycol in an amount of up to 30% with the aqueous or alcohol medium.

Id. Applicants submit that the rejection of the claims is moot in light of the present amendment.

Birkel teaches various various sprays and foams with a particular polymer combination. Birkel, like Bolich above, does not teach or suggest the method as recited in amended claim 24 or new claim 34 "wherein the cosmetic method imparts a waxy effect to the hair." For at least this reason this rejection should be withdrawn.

C. Rejection over *Carballada*

In the Office Action, the Examiner rejects claims 1-2, 4-11, and 13-25 under 35 U.S.C. § 103(a) as allegedly "being unpatentable over Carballada et al (6,585,965)" ("*Carballada*"). Final Office Action at 15. The Examiner states that Example IV in Carballada "teaches a composition comprising 38.90% water, 15% ethanol, 1% polyurethane-1 (anionic polymer), 12% PEG-8 . . . 30% dimethyl ether, among other components. The composition is in an aerosol container." *Id.* at 17. Applicants submit that the rejection of the claims is moot in light of the present amendment.

Like Bolich, and Birkel, Carballada does not teach or suggest the method as recited in amended claim 24 and new claim 34 "wherein the cosmetic method imparts a waxy effect to the hair."

For at least this reason this rejection should be withdrawn.

IV. DOUBLE PATENTING REJECTIONS

A. Rejection over Copending Application No. 10/279,036 in view of U.S. Patent No. 5,639,448

The Examiner maintains the provisional rejection of claims 1, 2, 4-11 and 13-25 on the ground of nonstatutory obviousness-type double patenting over claims 23-50 of copending Application No. 10/279,036 ("the '036 application") in view of U.S. Patent No. 5,639,448 ("US '448"). Final Office Action at 18. Applicants submit that the rejection of the claims is moot in light of the present amendment.

The combination of the '036 application and US '448 does not meet all of the present claim limitations. The combined references do not teach or suggest the method

as recited in amended claim 24 and new claim 34 "wherein the cosmetic method imparts a waxy effect to the hair." Therefore, Applicant respectfully requests that this rejection be withdrawn.

B. Rejection over Copending Application No. 10/479,170 in view of U.S. Patent No. 5,639,448

The Examiner maintains the provisional rejection of claims 1, 2, 4-11 and 13-25 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 20-36 of copending Application No. 10/479,170 ("the '170 application") in view of US '448 . Office Action at 21. Applicants submit that the rejection of the claims is moot in light of the present amendment.

The combination of the '170 application and US '448 does not meet all of the present claim limitations. The combined references do not teach or suggest the method as recited in amended claim 24 and new claim 34 "wherein the cosmetic method imparts a waxy effect to the hair." Therefore this rejection should be withdrawn.

V. CONCLUSION

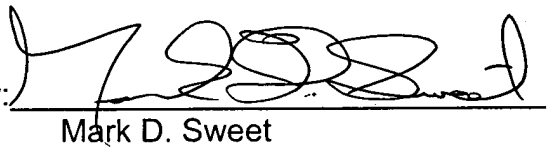
In view of the above arguments and amendments, Applicant respectfully requests reconsideration of the application and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 24, 2008

By: 

Mark D. Sweet
Reg. No. 41,469